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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,817	08/05/1999	SHARON R. GARBER	54419US1B014	5974

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ATTENTION: PETER L OLSON
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EXAMINER

LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/368,817

Applicant(s)

GARBER ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-43 is/are pending in the application.
- 4a) Of the above claim(s) 7-16, 19, 24, 25 and 36-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 20-23, 26-35 and 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-6, 20-23, 26-35 and 40-43 in Paper No. 22 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 26-29 and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowers et al (US 5,963,134 - cited by the applicant).

Re claims 1-6, Bowers et al discloses an RFID device comprising an interrogator [42, 43] for obtaining information from an RFID element 54 associated with an item 22 wherein the device is portable and adapted for carriage and hands-free use by a person (abs., lines 1+; col. 6, lines 38-42; col. 8, lines 1+; col. 9, lines 34+); an indicator for indicating information regarding one or both a class of materials (i.e., KA-452-11001, etc.) to which the item 54 belongs, and a desired location (i.e., main, engineering, etc.) for that item 54 wherein the indicator provides at least one of an audible and a visual indication (figs. 4 & 7; col. 7, lines 65-67; col. 10, lines 35+); wherein the information is obtained from memory within the RFID device (figs. 1 & 3; col. 9, lines 15-36); wherein the information is obtained

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from memory separate from the RFID device by upload (col. 10, lines 44+); wherein the information is obtained from the tag on the item (fig. 2; col. 8, lines 35-53).

Re claims 26-29, and 34-35: Bowers et al discloses a method of using an RFID device for identifying and locating items having an RFID element 54 associated therewith; comprising providing information to the RFID device 42 identifying a location; interrogating the items 22 with the RFID device 42 to determine the identity of the items 22; associating the items with the location; interrogating an RFID element 54 associated with a location; arranging and interrogating the items 22 in a series [KA-452-11001, KA-456-11221, etc.] so that the RFID device 42 can determine the location of one item with respect to other items; displaying the items and their respective locations; and downloading the information associating the items with the location to a computer 48, wherein the items are library materials (figs. 1 & 4; col. 9, line 41 through col. 10, line 21; col. 8, lines 50-56; and col. 11, lines 57-65).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and

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invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et al. The teachings of Bowers et al have been discussed above.

Re claims 20-22, Bowers et al discloses a method of using an RFID device comprising the steps of interrogating an item 22 having an RFID element 54 associated therewith; determining whether the interrogated item 22 belongs at the location; providing a signal; and wherein the item 22 is a library material and the location is a library storage location (col. 12, lines 3-23 and col. 15,, line 42 through col. 16, lines39).

Bowers et al fails to teach or fairly suggest the step of inputting information to the device to describe a location wherein the location has a separate RFID element and step of scanning the RFID element associated with that location.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a separate RFID element associated with each separated location (e.g., each individual shelf, room, etc.) into the library system as taught by Bowers et al in order to provide Bowers et al with a time consuming system wherein a mislocated or misshelved item/article can be determined readily based on the information of the location and the information of the item's location read from the RFID tags. Furthermore, such modification would have been an obvious extension as taught by Bowers et al, and therefore an obvious expedient.

Re claim 23, Bowers discloses a method of using a handheld RFID device 42 for reading information from an RFID element comprising the steps of interrogating the RFID tags 54 associated with each of a group of items 22, detecting the mislocated/misshelved item and providing an indication to the user of that location (col. 16, lines 1+).

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Bowers et al fails to specifically teach or fairly suggest that the system detecting where within the group of items a desired item should be placed.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the above capability into the library as taught by Bowers et al in order to provide Bowers with a more user-friendly system wherein a desired item's location being provided to the user readily, thus reduce labor in the finding process. Furthermore, such modification would have been an obvious extension as taught by Bowers et al, and therefore an obvious expedient.

7. Claims 30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et al in view of Frich (US 6,074,156). The teachings of Bowers et al have been discussed above.

Bowers et al has been discussed above but fails to teach or fairly suggest that the location is a cart and the method further comprising passing the RFID device into the cart, and wherein the location includes a shelf having an antenna associated therewith.

Frich teaches the above limitation with book cart 200 having titling mean 300 in fig. 1; col. 3, line 38 through col. 4, line 41; especially col. 4, lines 34-41.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Frich into the teachings of Bowers et al in order to provide Bowers et al a more accurate system, wherein the operator can only identify and locate items that are shelved but also can find items that are awaited for shelving (i.e., the returning/new items being placed on the cart(s) before moving to their respective shelving locations, etc.). Furthermore, such modification would help the operator to locate and find the desired item readily by providing him/her with the exact location of the desired item, and thus a more user-friendly system. Accordingly, such modification would have been an obvious extension as taught by Bowers et al, well within the ordinary skill in the art, and therefore an obvious expedient.

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8. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et al as modified by Frich as applied to claim 26 above, and further in view of Ghaffari et al (US 5,708,423 - cited by the applicant). The teachings of Bowers et al as modified by Frich have been discussed above.

Re claim 31, Bowers et al as modified by Frich have been discussed above but fails to teach or fairly suggest that the method further comprising the step of passing the cart through a tunnel.

Ghaffari et al teaches the above limitation with tunnel 84 in fig. 4; col. 6, lines 27-57.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ghaffari et al into the teachings of Bowers et al/Frich in order to provide Bowers et al/Frich with a quicker and easier way of determining items' location without checking each and every item individually. Furthermore, such modification would provide Bowers et al/Frich with a more user-friendly system by saving time and requiring less arduous labor. Accordingly, such modification would have been an obvious extension as taught by Bowers et al/Frich, well within the ordinary skill in the art, and therefore an obvious expedient.

9. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sone (US 2002/0,035,560 A1) in view of Cannon et al (EP 0,794,507 A2).

Re claims 40 and 41, Sone discloses a method of displaying related information of an item of interest among a larger group of items comprising the steps of providing a card 20 having an RFID element; transmitting information to the card 20 and storing that information in the RFID element (page 3, paragraph [0033] through page 4, paragraph [0036]); positioning RFID card readers 22 at positions near the item of interest; interrogating the RFID card 20 with the RFID card reader 22; and providing an indicator (display 12) of the information related to the item of interest (fig. 2; page 3, paragraph [0032]).

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Sone fails to teach or fairly suggest that the system is applied for locating an item of interest and the information providing of the visual display is the location of the item of interest relative to the location of the RFID.

Cannon et al teaches the above limitation with an interrogator 20 having a display 22 for displaying the location of an item of interest associated with an electronic/RF tag 15 (figs. 1-6; col. 2, line 28 through col. 4, line 52; and col. 5, line 58 through col. 6, line 41).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cannon et al into the teachings of Sone in order to provide Sone with a time consuming system wherein the location of the item of interest being displayed which leading the customer to his/her desired item readily, thus improving customer's satisfaction and increasing business. Furthermore, such modification would have been an obvious extension as taught by Sone, and therefore an obvious expedient.

10. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sone as modified by Cannon et al as applied to claim 40, and further in view of Marsh et al (EP 0,494,114 - cited by the applicant). The teachings of Sone as modified by Cannon et al have been discussed above.

Re claim 42, Sone/Cannon et al have been discussed above but fails to teach or fairly suggest that the visual display comprising a map of the area including the item.

Marsh et al teaches the above limitation with a map being generated on the display in col. 7, lines 9-13.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Marsh et al into the teachings of Sone/Cannon et al in order to provide Sone/Cannon et al with a more high tech system, wherein the operator/user is provide with all of the necessary information in the clearest way (i.e., the map direction) of the sought item/object, through which the operator will find the ease in identifying and locating the item/object, and thus

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providing a more user-friendly system. Accordingly, such modification would have been an obvious extension as taught by Sone/Cannon et al, well within the ordinary skill in the art, and therefore an obvious expedient.

11. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sone as modified by Cannon et al as applied to claim 40, and further in view of Bowers et al. The teachings of Sone as modified by Cannon et al have been discussed above.

Re claim 43, Sone/Cannon et al has been discussed above but fails to teach or fairly suggest that the item of interest is a library material, and the larger group of items comprise other library materials.

Bowers et al teaches the above limitation with an RFID associated with the library card, the item of interest is a library material, and the larger group of items comprise other library materials (i.e., books, magazines, video and audio tapes, etc.) (col. 3, lines 16+; col. 6, lines 43+ and col. 12, lines 24+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the library system as taught by Bowers et al into the teachings of Sone/Cannon et al in order to improve the library system wherein the desired materials can be found and checked out readily. Furthermore, such modification would have mere been a substitutions of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

Response to Arguments

12. Applicant's arguments with respect to claims 1-6, 20-23, 26-35 and 40-43 have been considered but are moot in view of the new ground(s) of rejection.

13. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the location

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information can be provided to an RFID reader, then one or more items can be interrogated, and then the two can be correlated to each other (applicant's argument filed 27 February 2002, page 8, 1st paragraph)) are not recited in the rejected claim(s) 26. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M, W, F, SAT 6:00-11:00 and T, TH 8:30-7:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Uyen-Chau N. Le

December 14, 2002



THIEN M. LE
PRIMARY EXAMINER